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10/677,968	10/01/2003	Katsuhisa Ogawa	1232-5170	9275
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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
CLOUD, JOIYA M				
ART UNIT		PAPER NUMBER		
2444				
NOTIFICATION DATE		DELIVERY MODE		
01/28/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/677,968

Applicant(s)

OGAWA, KATSUHIKA

Examiner

Joiya M. Cloud

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10/01/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the communication filed 10/29/2008. Claims 16-20 are PENDING. Applicant's arguments have been carefully considered, but are not persuasive.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Mersky (US Publication No. 2003/0037012 A1).

As per claim 16, Mersky teaches a service provision method of providing, via the Internet, a service to an apparatus to which a first network and a second network are connected, comprising: a first acquisition step of acquiring a host address of the apparatus, as connected to the first network (**Figure 1 and paragraph [0028], lines 15-21, where the agent system accessing the network via an ISP and initiates a connection to a transaction system using the acquired host address**), before the apparatus is connected to the second network (**merchant system**); a second acquisition step of acquiring owner information of the apparatus (**paragraph [0028], lines 21-25**); a third acquisition step of acquiring a network address of the second

network in accordance with the owner information acquired at the second acquisition step from a database storing the network address of the second network and the owner information of the apparatus (**paragraph [0030], where the definition tables stores the merchants (owner information) and corresponding network addresses**); a fourth acquisition step of acquiring, when a signal is transmitted from the apparatus via the second network, a host address and a network address of a sending side included in the signal (**paragraph [0029]**); and a provision step of providing the service, via the Internet (**paragraph [0030]**), to the apparatus via the second network in the case in which the host address acquired in said first acquisition step and the network address acquired in said third acquisition step coincide with the host address and the network address acquired in said fourth acquisition step (**paragraph [0031]**).

As per claim 17, Mersky teaches a method wherein, in said first acquisition step, a host address of an apparatus connected to a first network in an apparatus factory is acquired (**Figure 1**).

As per claims 18 and 19, Mersky teaches a method wherein, in said second acquisition step, a part of the network address of the second network is acquired from an Internet service provider for connecting the second network to the Internet and wherein, in said second acquisition step, a part of the network address of the second network is acquired from a DNS server (**paragraph [0030], lines 11-24**).

As per claim 20, claim 20 is substantially the same as claim 16 and list similar limitations, but in apparatus form rather than method form. Therefore, the rejection for claim 16 applies equally as well to claim 20.

Response to Arguments

Mersky fails to disclose, teach, or suggest: "...in the case in which the host address of the apparatus as connected to the first network and the network address of the second network coincide with the host address and the network address of the sending side"

As to the above point, Examiner respectfully disagrees. Examiner submits that no where does Applicant's instant specification specifically define, beyond the broadest reasonable interpretation and furthermore dictionary definition of the term "coincide," what or how the addresses of the instant claim coincide. Applicant's specification in paragraph, at best, references *redundancy* in which case examiner is unclear on whether Applicant's coinciding addresses refers to detecting redundant addresses (see page 18, lines 13-19), judging "whether or not the domain name exists," as suggested in page 30, lines 18-20, or determining a matching user based on a corresponding addresses associated with a user in a database.

Page 8, lines 23 through page 9 lines 1-4 of Applicant's specification recite,

"Then, in the case in which the terminal service provision site 6 has received a packet from the IPv6 compatible terminal apparatus 1 connected to the LAN 29 (15 of FIG. i), the terminal service provision site 6 judges whether or not a host address and a network address of a sender address of the packet coincide with the host address of the IPv6 compatible terminal apparatus 1A and the network address of the LAN 29."

Again, Applicant's specification merely states that a judgment of whether or not addresses coincide occurs, however, *how* that judgment or coincidence is carried out is unclear and what constitutes a *coincidence* of addresses. Thus, Examiner has interpreted the coinciding of addresses to mean the occurrence of a matching address found in a database to verify a corresponding terminal address. As such, Mersky teaches matching via a database, merchants to corresponding network and URL addresses, see paragraph [0030].

Furthermore, the claim only requires providing the service via the Internet, to the apparatus via the second network in the case in which the host address acquired...coincide..." According to the claim language, the claim appears to be a conditional statement, that carries out the method of "a provision step of providing" *if* or "in the case" that the addresses coincide. Therefore, the claim does not require that the addresses must coincide. Therefore, Examiner suggests Applicant amend the claim language to further define Applicant's intended claimed invention.

CONCLUSION

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMC

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444

January 20, 2009

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